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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,352	02/06/2004	Gerd Scharninghausen	ESN-45	5252

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EXAMINER	
EWALD, MARIA VERONICA	
ART UNIT	**PAPER NUMBER**
1791	

MAIL DATE	DELIVERY MODE
11/24/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/774,352	SCHARNINGHAUSEN ET AL.	
	Examiner	Art Unit	
	MARIA VERONICA D. EWALD	1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 October 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5,8-19,21 and 22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5,8-19* is/are rejected.

7)☒ Claim(s) *21 and 22* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *06 February 2004 and 23 October 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

13. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 22, 2008 has been entered.

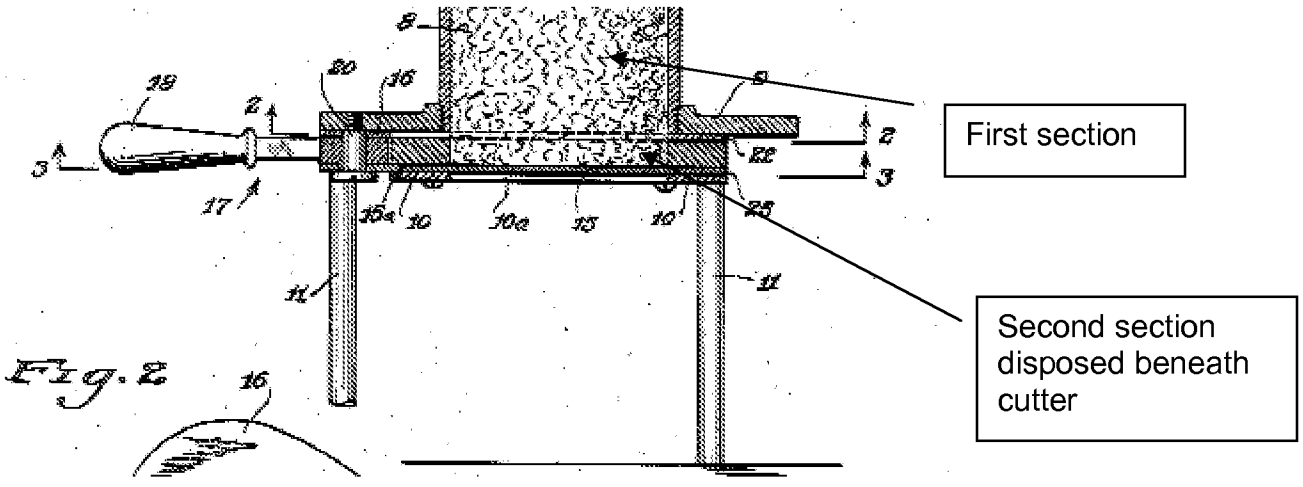
Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 – 3, 5, 8 – 10, 12 and 16 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenstone, et al. (U.S. 2,101,755). Rosenstone, et al. teach a portioning device for portioning a bulk material, comprising: a forming space adapted to be filled by a mass of the bulk material, the forming space bounded by a wall (figure 1) for forming the mass, the forming space (figure 1; column 1, lines 30 – 40) having first and second sections, the wall including a slit between the first and second sections of the forming space (figure 1) and an output opening (figure 1); the second section

disposed between the slit and the output opening, and a cutting device for portioning the mass filled into the forming space into a plurality of mass portions (item 16 – figure 1), the cutting device having a cutter that is at least partially introducible through the slit (figure 1) into the forming space, and each of the plurality of mass portions being output as an end product from the forming space through the output opening; wherein the slit extends far enough through the wall so that the cutter can cut completely through a cross section of the forming space (figure 1); wherein the cutting device is introducible into the forming space in a direction that lies approximately perpendicular to the direction in which the mass is filled into the forming space (figure 1); wherein the forming space has a filling opening through which the mass can be filled into the forming space (column 2, lines 28 – 30); wherein the forming space has a geometry matched to the form of the end product (figure 1); wherein the forming space is defined inside a tube (item 7 – figure 1) through which the mass is axially transportable (figure 1).



The reference also teaches that the cutter is introducible into the forming space at a place such that each of the plurality of mass portions formed, when the cutter is introduced, is supported by at least part of the wall (figure 1); wherein the slit is spaced apart at a distance from an output opening of the forming space such that a section of the forming space corresponds at least approximately to the size of each of the plurality of mass portions (figure 1); wherein the wall is substantially cylindrical and the slit almost completely penetrates the wall (figure 1); wherein there are means for fastening the cutting device as an attachment to a device for transporting and/or mincing bulk material (figure 1; column 1, 40 – 55; column 2, lines 1 – 20); wherein the geometry has a cross section that is substantially rotationally symmetrical (figures 1 and 2).

Rosenstone, et al., however do not teach that the wall has a unitary construction; however, such is an obvious modification to one of ordinary skill in the art and would not disrupt or alter the function of the slicing machine. Per MPEP 2144.04, it has been held that merely making something integral or separate is not in and of itself patentable and is a matter of engineering or design choice. See *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (A claim to a fluid transporting vehicle was rejected as obvious over a prior art reference which differed from the prior art in claiming a brake drum integral with a clamping means, whereas the brake disc and clamp of the prior art comprise several parts rigidly secured together as a single unit. The court affirmed the rejection holding, among other reasons, “that the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice.”)

Furthermore, Rosenstone, et al. may not teach that the shape of the forming space is oval; however, such is merely a change in shape and is also not in and of itself patentable. Per MPEP 2144.04, changing the shape of the forming cavity is an obvious modification depending on the product shape desired and would not alter the functionality of the slicing machine. See *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)

Claims 13, 15 and 18 – 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenstone, et al. Rosenstone, et al. teach a device for transporting and/or mincing bulk material, comprising: a forming space adapted to be filled by a mass of the bulk material, the forming space bounded by a wall (see figure 1 above) for forming the mass, the forming space having first and second sections, the wall including a slit between the first and second sections of the forming space and an output opening (figure 1); the forming space having a geometry matched to the form of an end product, the second section disposed between the slit and the output opening, and a cutting device for portioning the mass filled into the forming space into a plurality of mass portions (item 16 – figure 1), the cutting device having a cutter that can be introduced through the slit at least partially into the forming space, and each of the plurality of mass portions being output as the end product from the forming space through the output opening (figure 1); wherein the slit extends far enough through the wall so that the cutter can cut completely through the cross section of the forming space (figure 1); wherein

the device is further comprised of means for transporting the mass, the means of transport being discontinuously operable, and the timing of the discontinuous operation cooperating with the introductory motion of the cutter into the forming space for portioning the mass into the plurality of mass portions (column 2, lines 25 – 32); wherein the geometry has a cross-section that is substantially rotationally symmetrical (figure 1).

Rosenstone, et al., however, do not teach that the wall is of a unitary construction or that the geometry has a cross-section that is oval.

With respect to the wall having a unitary construction, such is an obvious modification to one of ordinary skill in the art and would not disrupt or alter the function of the slicing machine. Per MPEP 2144.04, it has been held that merely making something integral or separate is not in and of itself patentable and is a matter of engineering or design choice. See *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (A claim to a fluid transporting vehicle was rejected as obvious over a prior art reference which differed from the prior art in claiming a brake drum integral with a clamping means, whereas the brake disc and clamp of the prior art comprise several parts rigidly secured together as a single unit. The court affirmed the rejection holding, among other reasons, "that the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice.")

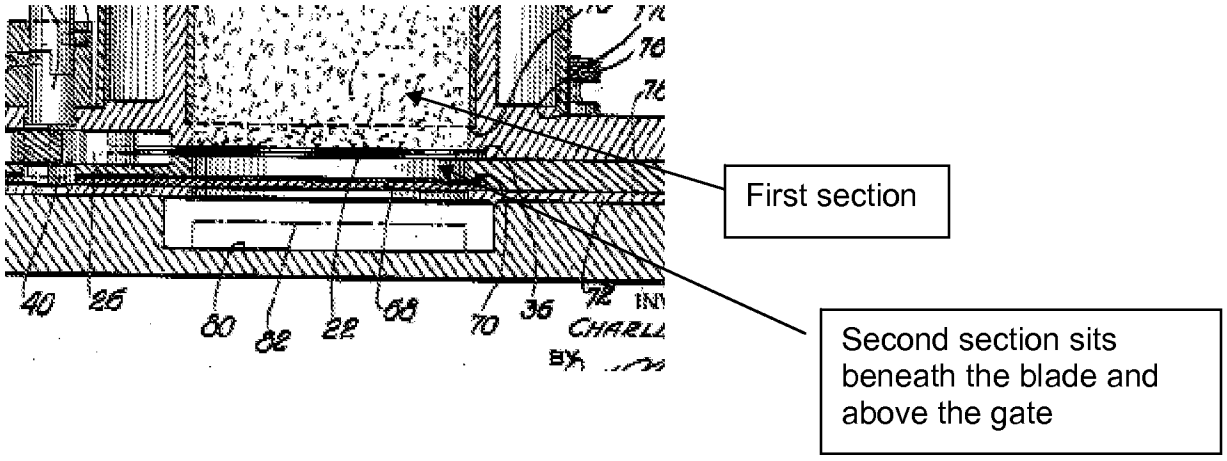
Furthermore, though Rosenstone, et al. may not teach that the shape of the forming space is oval, such is merely a change in shape and is also not in and of itself patentable. Per MPEP 2144.04, changing the shape of the forming cavity is an obvious modification depending on the product shape desired and would not alter the

functionality of the slicing machine. See *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)

The Examiner is noting that Applicant has claimed in claim 15 a "means for transporting the mass, which is discontinuously operable." The Examiner is interpreting such a limitation as an invocation of 35 U.S.C. 112, 6th paragraph and as such, such means are identified as a rotary vane pump or double screw pump which can be discontinuously operated and the equivalents thereof of such elements. Because Rosenstone, et al. teach a screw and spring assembly, which is manually operated and can be discontinuously operated to transport and press the bulk material to the outlet opening, the Examiner identifies the components of Rosenstone, et al. as meeting the limitations of claim 15.

Claims 1 – 3, 5, 8 – 12 and 16 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ackerman (U.S. 2,500,973). Ackerman teach a portioning device for portioning a bulk material, comprising: a forming space adapted to be filled by a mass of the bulk material, the forming space (figure 1) bounded by a wall (figure 1) for forming the mass, the forming space having first and second sections, the wall including a slit between the first and second sections of the forming space and an output opening (figure 1); the second section disposed between the slit and the output opening, and a cutting device for portioning the mass filled into the forming space into a plurality of mass portions (items 22 and 24 – figures 6 and 7), the cutting device having a cutter that is at least partially introducible through the slit (figures 1, 6 and 7) into the forming

space, and each of the plurality of mass portions being output as an end product from the forming space through the output opening; wherein the slit extends far enough through the wall so that the cutter can cut completely through a cross section of the forming space (figure 1); wherein the cutting device is introducible into the forming space in a direction that lies approximately perpendicular to the direction in which the mass is filled into the forming space (figure 1); wherein the forming space has a filling opening through which the mass can be filled into the forming space (figure 1); wherein the forming space has a geometry matched to the form of the end product (figure 1); wherein the forming space is defined inside a tube (item 10 – figure 1) through which the mass is axially transportable (figure 1).



Furthermore, the reference also teaches that the cutter is introducible into the forming space at a place such that each of the plurality of mass portions formed, when the cutter is introduced, is supported by at least part of the wall (figure 1); wherein the

slit is spaced apart at a distance from an output opening of the forming space such that a section of the forming space corresponds at least approximately to the size of each of the plurality of mass portions (figure 1); wherein the wall is substantially cylindrical and the slit almost completely penetrates the wall (figure 1); wherein the cutter is a two-bladed, rotatable cutting knife (items 22 and 24 – figures 4 and 5; column 3, lines 20 – 65); wherein there are means for fastening the cutting device as an attachment to a device for transporting and/or mincing bulk material (figure 1; column 3, lines 1 – 30); wherein the geometry has a cross section that is substantially rotationally symmetrical (figures 1 and 4 – 5).

Ackerman, however, does not teach that the wall is of a unitary construction or that the geometry has a cross-section that is oval.

With respect to the wall having a unitary construction, such is an obvious modification to one of ordinary skill in the art and would not disrupt or alter the function of the slicing machine. Per MPEP 2144.04, it has been held that merely making something integral or separate is not in and of itself patentable and is a matter of engineering or design choice. See *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (A claim to a fluid transporting vehicle was rejected as obvious over a prior art reference which differed from the prior art in claiming a brake drum integral with a clamping means, whereas the brake disc and clamp of the prior art comprise several parts rigidly secured together as a single unit. The court affirmed the rejection holding, among other reasons, “that the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice.”)

Furthermore, though Ackerman may not teach that the shape of the forming space is oval, such is merely a change in shape and is also not in and of itself patentable. Per MPEP 2144.04, changing the shape of the forming cavity is an obvious modification depending on the product shape desired and would not alter the functionality of the slicing machine. See *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)

Claims 13, 15 and 18 – 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ackerman. Ackerman teaches a device for transporting and/or mincing bulk material, comprising: a forming space adapted to be filled by a mass of the bulk material, the forming space bounded by a wall (figure 1) for forming the mass, the forming space having first and second sections, the wall including a slit between the first and second sections of the forming space and an output opening (figure 1), the forming space having a geometry matched to the form of an end product, the second section disposed between the slit and the output opening, and a cutting device for portioning the mass filled into the forming space into a plurality of mass portions (item 22 and 24 – figures 1 and 4 – 5), the cutting device having a cutter that can be introduced through the slit at least partially into the forming space, and each of the plurality of mass portions being output as the end product from the forming space through the output opening (figure 1); wherein the slit extends far enough through the wall so that the cutter can cut completely through the cross section of the forming space (figure 1); wherein the geometry has a cross-section that is substantially rotationally symmetrical (figure 1).

Ackerman, however, does not teach that the wall is of a unitary construction or that the geometry has a cross-section that is oval.

With respect to the wall having a unitary construction, such is an obvious modification to one of ordinary skill in the art and would not disrupt or alter the function of the slicing machine. Per MPEP 2144.04, it has been held that merely making something integral or separate is not in and of itself patentable and is a matter of engineering or design choice. See *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (A claim to a fluid transporting vehicle was rejected as obvious over a prior art reference which differed from the prior art in claiming a brake drum integral with a clamping means, whereas the brake disc and clamp of the prior art comprise several parts rigidly secured together as a single unit. The court affirmed the rejection holding, among other reasons, "that the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice.")

Furthermore, though Ackerman may not teach that the shape of the forming space is oval, such is merely a change in shape and is also not in and of itself patentable. Per MPEP 2144.04, changing the shape of the forming cavity is an obvious modification depending on the product shape desired and would not alter the functionality of the slicing machine. See *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)

The Examiner is noting that Applicant has claimed in claim 15 a "means for transporting the mass, which is discontinuously operable." The Examiner is interpreting such a limitation as an invocation of 35 U.S.C. 112, 6th paragraph and as such, such

means are identified as a rotary vane pump or double screw pump and the equivalents thereof of such elements which can be discontinuously operated. Because Ackerman teaches a screw and spring assembly, which is manually operated and can be discontinuously operated to transport and press the bulk material to the outlet opening, the Examiner identifies the components of Ackerman as meeting the limitations of claim 15.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Rosenstone, et al. or Ackerman in view of Abler (U.S. 5,230,267). Rosenstone, et al. and Ackerman teach the characteristics previously described but do not specifically teach that there is a smoothing belt and a shaping surface.

In a method to form and subsequently process meat or other food slices, Abler teaches the use of a smoothing belt used in conjunction with a conveyor (items 15 and 16 – figure 1). The smoothing belt functions to uncurl or ensure that the slices remain flat as they are transported on the conveyor.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to configure the apparatus of either Rosenstone, et al. or Ackerman with a conveyor belt and smoothing surface as taught by Abler, for the purpose of conveying the meat patties to its final processing station, while at the same time, ensuring that the surface of the patties retain their flat shape or final shape.

Allowable Subject Matter

15. Claims 21 – 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The closest prior art references of Rosenstone, et al. and Ackerman fail to teach or suggest, either alone or in combination, that the second section of the forming space has a slightly larger diameter than the first section.

References of Interest

16. Epstein, et al. (U.S. 4,744,130) and House (U.S. 3,733,652) are cited of interest to show the state of the art. Epstein teaches a molding space which shapes a bulk ground meat material into a cone shape. A blade is displaced above the molding space to sever the meat. The resulting cone-shaped meat is detached from the pressure source and the mold cavity peeled from the formed meat. House teaches a slicing machine wherein a bulk meat is severed into individual patties. A blade is introduced into a slit which slices the meat from the hopper.

Response to Arguments

17. Applicant's arguments, see pages 6 – 7, filed October 22, 2008, with respect to the reference of Volkl have been fully considered and are persuasive. Thus, the rejection of claims 1 and 13 and their respective dependent claims has been withdrawn. The Examiner agrees that the wall of Volkl is not of unitary construction and cannot be

so, because a portion of the wall is actually the wall of the calibrating plate which must be reciprocated to release the patty.

With respect to the reference of Rosenstone, et al., however, the Examiner does not find the arguments persuasive. Applicant argues that the wall of Rosenstone, et al. (item 7 – figure 1) and the plates to which the plates are attached lack a unitary construction. To this point, the Examiner agrees, however, the Examiner contends that fabricating the wall and plates of Rosenstone, et al. as a unitary piece is well within the level of one of ordinary skill in the art and would have been an obvious design choice. Furthermore, if the forming space were configured as a single piece, it would not alter the functionality of the apparatus. Thus, the Examiner maintains the rejection of claims 1 and 13 and their associated dependent claims as obvious over Rosenstone, et al.

With respect to the reference of Ackerman, Applicant similarly argues that Ackerman fails to teach a wall of unitary construction. To this point, the Examiner also agrees; however, the Examiner contends that fabricating the walls and plates of Ackerman as a single, unitary piece is well within the level of one of ordinary skill in the art and would have been an obvious design choice. Furthermore, if the forming space were configured as a single piece, it would not alter the functionality of the apparatus. Thus, the Examiner maintains the rejection of claims 1 and 13 and their associated dependent claims as obvious over Ackerman.

With respect to the remaining dependent claims, as noted above, the remaining dependent claims have been rejected.

With respect to new claims 21 and 22, the Examiner has indicated such features allowable.

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARIA VERONICA D. EWALD whose telephone number is (571)272-8519. The examiner can normally be reached on M-F, 8 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MVE

/Maria Veronica D Ewald/
Examiner, Art Unit 1791